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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/921,204
Filing Date: August 02, 2001
Appellant(s): AUTTERSON, CHRISTOPHER S.

MAILED

FEB 23 2006
Group 3700

Irving M. Weiner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 8 December 2005 appealing from the Office action mailed 6 April 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

US 2,054,596	Ford, Thomas L.	9-1936
US 2,362,181	Zimmerman, Morton W.	11-1944
US 5,246,161	Kapp, Mort	9-1993
DE 2723357 A1	Jenniches, K. H.	11-1978

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ford (US 2,054,596) in view of Zimmerman (US 2,362,181) and Jenniches (DE 27 23 357 A; PTO translation provided in the Office Action of 6 April 2005). The rejection is set forth in section 3 of the Office Action of 6 April 2005.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kapp (US 5,246,161) in view of Zimmerman (US 2,362,181). The rejection is set forth in section 4 of the Office Action of 6 April 2005.

(10) Response to Argument

In section 1 of the appellant's arguments, as best determined, the appellant presents the following arguments with respect to claim 1:

- Ford does not disclose a shipping/packaging carton.
- Ford does not disclose an advertisement.
- A person having ordinary skill in the art of methods of advertising would not look to Ford's box for holding a plurality of units, nor look to Zimmerman's carton. And a person having ordinary skill in the art of methods of advertising would not be skilled in profit, income, or package making.
- Jenniches does not teach a shipping/packaging carton.
- The invention is in a crowded art, therefore small advancements should be regarded as significant.
- The lack of implementation (e.g. long-felt need) of the claimed invention is evidence of non-obviousness.
- None of the cited references are directed to a shipping carton.
- The rejection is based on improper hindsight.
- The invention is directed to a different problem than that of the cited references.
- The cited references are from different fields than the claimed invention.
- The rejection is based on an excessive number of references.

In reviewing the appellant's arguments, the first consideration is to the term "shipping/packaging carton". As the claims are to be given their broadest reasonable

interpretation, consistent with the specification, the term “shipping/packaging carton” may be considered to mean a shipping and/or packaging carton. Ford describes the carton as “boxed merchandise” that are shipped from the factory (Page 1, lines 17-20) and uses box and carton interchangeably (see for example Page 1, line 1). Accordingly Ford constitutes a shipping/packaging carton, Zimmerman constitutes a shipping carton, and Jenniches constitutes a packaging carton.

In response to the argument that Ford does not disclose an advertisement, it is respectfully submitted that the specification does not contain this narrow definition presented by the appellant and therefore a very broad interpretation of the term “advertisement” should be used. However, Ford teaches that the cartons are stacked on shelving with the indicia exposed (Page 1, lines 17-25). Thus the indicia may be considered a notice designed to attract public attention and constitute an advertisement within the definition presented by the appellant.

In resolving the level of ordinary skill in the art, one must look to the subject matter to which the claimed invention pertains. It is respectfully asserted that the art to which the claimed invention pertains is not limited to methods of advertising. While the preamble of Claim 1 indicates a method of advertising, the claimed subject matter also extends into the provision of carton structure, simultaneous printing, carton ownership, and interaction between two distinct parties. Accordingly, one having ordinary skill in the art to which the claimed invention pertains would have to have at least a basic

understanding of the subject matter involved, which includes advertising principles, basic carton structure, basic carton printing capabilities, merchandise ownership, and basic business practice. While it is not presumed that the artisan is an expert in the above fields, one cannot assume that the artisan of ordinary skill is ignorant of the above subject matter since claim 1 clearly brings the subject matter to bear.

Accordingly, Ford, Zimmerman, and Jenniches are pertinent to the claimed subject matter. And the basic understanding of basic business practices would have placed profit motivation within the knowledge generally available to one having ordinary skill in the art. Further, it is respectfully asserted that advertising, by its very nature, is concerned with increased sales and profit and one of ordinary skill in the art would have had at least a fundamental understanding of sales and profit principles.

In response to the appellant's argument that the invention is in a crowded art, the question under 35 U.S.C. 103(a) is obviousness, not advancement of the art. If the claimed invention is *prima facie* obvious, assertions of advancement in the art are immaterial.

The question of lack of implementation is a question of evidence. Establishing long-felt need requires objective evidence that an art-recognized problem existed in the art for a long period of time without solution. The failure to solve a long-felt need may be due to factors such as lack of interest or lack of appreciation of an invention's potential or marketability rather than want of technical know-how. *Scully Signal Co. v. Electronics*

Corp. of America, 570 F.2d 355, 196 USPQ 657 (1st. Cir. 1977). Appellant has submitted no evidence to support the assertion of long-felt need. The arguments of counsel cannot take the place of evidence in the record. *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965).

In response to the argument that the conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to the argument that the invention is directed to a different problem than the cited reference, it is respectfully submitted that Jenniches is directed to the problem envisioned by the appellant. Since the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantage ascribed by appellant. *In re Wiseman*, 201 USPQ 658.

In response to argument that an excessive number of references have been combined, reliance on a large number of references in a rejection does not, without more, weigh

against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to the arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In section 2, the appellant questions the rejection based upon presentation. It is respectfully asserted that the method of claim 1 is directed to the provision of a final product. As such, when the method is performed, it results in a final product or article. Accordingly, when the method of Ford-Zimmerman-Jenniches is performed, the article of claim 11 is met by presentation of the finished method. The appropriate statements of obviousness were presented in the discussion of the combination with respect to claim 1. Further, appellant asserts non-obviousness based upon the arguments set forth in section 1; the response to said arguments are presented above.

In section 3 of the appellant's arguments, as best determined, the appellant presents the following arguments with respect to claim 11:

- Kapp does not disclose a shipping/packaging container.
- Forming the container wall from a corrugated material is counter to the teachings of Kapp.

- The rejection does not consider the claim as a whole in considering the printed matter. The presence or absence of a specific functional relationship is not dispositive of obviousness.
- A *prima facie* case of obviousness has not been established with respect to:
 - Why it would have been obvious to have the first party own the carton.
 - Why it would have been obvious to provide a second advertisement of a second party.
 - Why it would have been obvious for the first party to allot the area for the advertisement and determine the size and location of the advertisement.
 - Why it would have been obvious to place the second advertisement in an area that would otherwise be blank.
- Appellant's invention solves and is directed to a different problem than that of the cited reference.

Claim 11 is an article claim and its analysis is very different from the method of claim 1. As previously noted, the claim is a product-by-process claim. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

In response to the argument that Kapp is not a shipping/packaging carton, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Kapp is fully capable of functioning as either a shipping or packaging carton.

In response to the argument that forming the container wall from a corrugated material is counter to the teachings of Kapp, Kapp teaches a perforated feature 26 for separation of the card top. This feature is in no way disabled upon forming the carton from a corrugated material and the resultant carton and removable card both result in a more durable and longer-lasting product.

In response to the arguments concerning the applicability of *In re Gulack*, it is respectfully noted that Kapp fully anticipates advertisements (see Col. 3, lines 3-6). And while no concession is made to arguments presented by appellant, it is respectfully asserted that they are ineffective in overcoming the direct teachings of Kapp.

The resultant structure of claim 11 is a parallelepiped carton with advertisements in two locations. Ownership of the carton is an intended use. Ownership of the advertisements is an intended use. The party who decides the location and size of the advertisements is an intended use. The absence of a disclosure relating to the

functions does not defeat the finding of obviousness since it is well settled that the recitation of a new intended use for an old product does not make a claim to that old product patentable. *In re Schneller*, 44 USPQ 2d 1429 (Fed Cir. 1997); *In re Spada*, 15 USPQ 2d 1655 (Fed. Cir. 1990); and *In re Benner*, 82 USPQ 49 (CCPA 1949). The placement in of an advertisement in an area that would otherwise be blank is based on the process of making the device and does not result in a structural difference in the final product. The method of forming the device is not germane to the issue patentability of the device itself. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985)

In response to the arguments that the invention solves and is directed to a different problem than that of the cited references, all benefits of claimed invention need not be explicitly disclosed in references to render claim unpatentable under 35 USC 103. See *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir. 1990). Since the claimed subject matter would have been obvious from the references, it is immaterial that the references do not state the problem or advantage ascribed by applicant. See *In re Wiseman*, 201 USPQ 658.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

J. Greg Pickett
J. Gregory Pickett
Examiner

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